

I. **REMARKS**

The final Office Action dated June 15, 2006, has been received and carefully noted. The following remarks and enclosed Declaration are being submitted as a full and complete response thereto.

Claims 1 – 23 are pending. No amendments to the claims are made at this time.

Applicants respectfully request consideration of the remarks below and the enclosed Declaration. Entry of this evidence is proper under 37 C.F.R. § 1.116 since the evidence: (a) places the application in condition for allowance for reasons discussed herein; (b) does not raise any new issues regarding further search and/or consideration since the evidence amplifies issues previously discussed throughout prosecution; and (c) places the application in better form for appeal, should an appeal be necessary. The Declaration and related remarks are necessary as they are made in reply to arguments raised in the rejection.

Claims 1-23 were rejected under 35 U.S.C. § 102(e) over Yuki et al. As noted in the Response filed on April 3, 2006, Applicants respectfully reemphasize that the present application is entitled to an invention date of August 2, 2002, which is prior in time to the August 7, 2002 U.S. filing date of U.S. Patent No. 6,746,993 (hereinafter 'Yuki '993'). Applicants respectfully resubmit that Yuki '993 is not a proper reference as to the claims of the present application. As noted in the Response, Yuki '993 is a continuation-in-part of U.S. Application No. 10/212,784 (published as U.S. Patent Publication No. 2003/0036488) (hereinafter "Yuki '488"). Applicants submit that the presently claimed invention is patentable over Yuki '488. As such, this rejection is traversed.

Claim 1 of the presently claimed invention is directed to a viscosity index improver which comprises "oil soluble copolymer (A) having a weight-average molecular weight of 3,000 - 500,000 and comprising units of 5-90% by weight of a monomer (a)..., units of 5-90% by weight of at least one monomer (b)..., and units of 5-50% by weight of (c) an unsaturated monomer having at least one group selected from hydroxyl, amide and carboxyl groups" (claim 1) (emphasis added).

In contrast, Yuki '488 discloses a Polymer (A), which "comprises units of at least one monomer selected from the group consisting of an acrylic monomer (hereinafter referred to as (a))..., an alkyl alkenyl ether (hereinafter referred to as (b)), an alkenyl carboxylate (hereinafter referred to as (c)) and a nitrogen-containing unsaturated monomer (hereinafter referred to as (d))" (Yuki '488, page 1, paragraph [0011]). Yuki '488 further discloses that the nitrogen-containing unsaturated monomer (monomer (d)) can include amino-containing monomers (d1), amide-containing monomers (d2), and nitro-containing monomers (d3) (Yuki '488, page 3, paragraph [0052]. Further, Yuki '488 discloses that additional monomers (e) through (m) may be present in Polymer (A) (Yuki '488, pages 3-4, paragraphs [0062] – [0091]). Yuki '488 also discloses:

The sum amount of (a) and (b)... [is] preferably at least 30%, more preferably 50-100%, particularly 80-100% against total amount of monomer(s) to be used for synthesis (A)... If (c) and/or (d) is used together with (a) and/or (b), the amount of (c) preferably at most 45%, particularly at most 40%, and the amount of (d), preferably at most 12%, particularly at most 10%... If (d) to (m) is employed by requirement, together with the monomers (a) to (c)..., the sum amount... is preferably 0-20%, particularly 0.1 to 10%...

(Yuki '488, page 4, paragraphs [0093]- [0094]) (emphasis added).

Applicants submit that Yuki '488 fails to disclose with sufficient specificity the composition of the presently claimed invention. According to the Manual of Patent Examining Procedure (MPEP),

[W]hen the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with 'sufficient specificity to constitute an anticipation under the statute'" (MPEP § 2131.03).

Applicants submit that without the benefit of hindsight, one of ordinary skill in the art would not have known to select the specific monomers in the specific weight percentages of the presently claimed invention based on the teachings of Yuki '488. In other words, Applicants submit that Yuki '488 does not teach or suggest the claimed composition with sufficient specificity, let alone the critical range of components and the unexpected benefits of having a composition having monomers containing an amide, carboxyl, or hydroxyl group as constituent elements which are always present in a range of 5 to 50% (claim 1). Further, Applicants submit that Yuki '488 discloses that "[a]mong the monomers (d), preferred are monomers (d1)" (Yuki '488, page 3, paragraph [0061]). Applicants note that monomer (d1) of Yuki '488 is an amino-containing monomer, and monomer (c) of present claim 1 is an unsaturated monomer having at least one group selected from hydroxyl, amide and carboxyl groups.

Applicants also note that the Examples of Yuki '488 do not disclose compositions containing monomer (c) of the presently claimed invention, or unsaturated monomers having at least one group selected from hydroxyl, amide, and carboxyl groups.

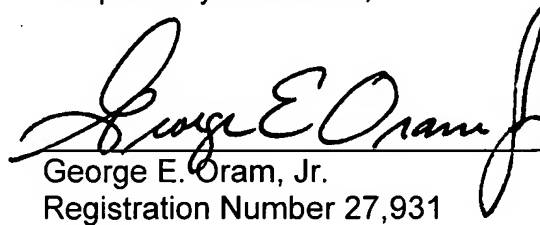
Applicants submit that the Declaration demonstrates that compared to the compositions which do not contain monomer (c) of claim 1, compositions of the presently claimed invention provide unexpected properties of low temperature viscosity, shear stability, and viscosity index (Declaration, page 4, Table 1). The Declaration compares compositions of the presently claimed invention with compositions of Yuki '993, which is a continuation-in-part of Yuki '488. Applicants submit that compositions of the presently claimed invention, which always contain monomer (c), are unexpectedly superior to the compositions which do not contain monomer (c). Applicants also note that the Examples of Yuki '993 do not teach or suggest the copolymer of claim 7, which "contains units of up to 15% by weight of at least one monomer selected from the group consisting of (d)..., (e)..., (f)..., (g)..., (h)..., (i)..., (j)..., and (k)..." (emphasis added). In contrast, the Examples of Yuki '993 have 30 to 38% by weight of monomers (d1) and (k1). See Declaration, page 4, Table 1.

For at least the above reasons, Applicant respectfully request reconsideration and withdrawal of the rejection of claims 1-23 under 35 U.S.C. § 102(e) over Yuki et al.

II. CONCLUSION

In the event that this paper is not considered to be timely filed, an appropriate extension of time is requested. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 103176-00003.

Respectfully submitted,

  
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Enclosure: Declaration

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